

REMARKS

In the Final Office Action¹ dated November 17, 2006, the Examiner rejected claims 1-21 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 09/795,219 to Walters et al. ("*Walters*")². Based on the following remarks, Applicants respectfully traverse the rejection of claims 1-21 under 35 U.S.C. § 102(e), and the timely allowance of the pending claims.

I. Rejection of claims 1-21 under 35 U.S.C. § 102(e) as being allegedly unpatentable over *Walters*

The Examiner asserts *Walters* anticipates claims 1-21 (Final Office action at p. 2). Applicants respectfully disagree. In order to properly establish that *Walters* anticipates Applicants' claimed invention, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in *Walters*. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Walters fails to support a *prima facie* case of anticipation because this reference does not disclose each and every element of claims 1-21. For example, claim 1 recites a method including, for example, the step of "receiving account preference information from the applicant, the account preference information describing the applicant's preferences concerning various features of the financial account product." The

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² Applicants note the Final Office action (at p. 2) asserts that claims 1-21 are rejected under 35 U.S.C. § 102(e). However, the Final Office action (at p. 6) apparently sets forth the rejection of claims 16-21 under 35 U.S.C. § 103(a). Applicants respectfully request clarification as to the basis of the rejection of claims 16-21 in the next communication by the Examiner.

Examiner asserts that *Walters* teaches these recitations at paragraphs 0011-0018 (Final Office action at p. 3). Applicants respectfully disagree.

Walters discloses “a computer readable memory storing a computer program executable by a processor.” The program disclosed by *Walters* comprises:

“a client questionnaire module that presents a first set of questions to a client and receives a first set of answers, presents subsequent sets of questions to the client which are customized based on the answers to the first and other previous sets of questions so that the client is not asked redundant, unnecessary, or inappropriate questions, and receives answers to the subsequent sets of questions, wherein the questions request (A) personal information comprising client and dependent names, ages, and marital status; (B) financial information on one or more of savings accounts, investment accounts, insurance policies, retirement accounts, stock options, trusts, history of gifts to family members, loans, charitable contributions, charitable trusts, property, businesses, and income sources; and (C) goal information comprising retirement age and income goals and estate related goals.”

(*Walters* at ¶ 0012) (Emphasis added.)

Thus, *Walters* discloses receiving personal, financial, and goal information from a client and not “account preference information, describing the applicant’s preferences,” concerning various features of the financial product, as recited in independent claim 1. Indeed, *Walters* does not even teach or suggest receiving preference information concerning a financial product. Accordingly, *Walters* does not anticipate independent claim 1.

Interestingly, in rejecting claim 1, the Examiner recognizes the requirement that the “Examiner is entitled to give the claim limitations their broadest reasonable interpretation in light of the Specification” (Final Office action at pp. 2-3). Applicants agree with the Examiner in that although the Examiner is entitled to interpret the claim

terms broadly, such interpretation cannot be unreasonable (M.P.E.P. § 2111). In relevant part, M.P.E.P. § 2111 indicates that “pending claims must be given their broadest reasonable interpretation consistent with the specification.” While the Examiner may not be required to “interpret claims in applications in the same manner as a court would interpret claims in an infringement suit,” the Examiner is required to apply “to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” M.P.E.P. § 2111.

Here, the broadest reasonable interpretation of the “account preference information,” as recited in the pending claims, must be consistent with the interpretation of the phrases that those skilled in the art would reach. *See Id.* However, in rejecting claim 1, the Examiner incorrectly asserts that “customization information” used “to assist in the selection of a financial product and/or financial account,” as allegedly disclosed by *Walters* constitutes “account preference information” (Final Office action at p. 3).

Applicants respectfully submit that these assertions are not consistent with the interpretation of the term as known in the art and within the context of Applicants’ specification. In fact, because the information disclosed by *Walters* is not applicant’s preference information concerning a financial product, the Examiner’s interpretation of “account preference information,” as recited in claim 1 is unreasonable.

Moreover, M.P.E.P. § 2173.01 states, in relevant part,

Applicants are their own lexicographers. They can define in the claims what they regard as their invention

essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the Specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Here, the plain language of claim 1 defines “account preference information” as “describing the applicant’s preferences concerning various features of the financial account product.” The Examiner is incorrect in asserting that because *Walters* may receive information from an applicant, this information “can be seen as financial ‘account preference information’” (Final Office action at p. 3.) Such a position is unreasonable given the plain language of the claims and the description of the terms in the context of Applicants’ specification. For at least the reasons stated above, the rejection of claim 1 under 35 U.S.C. § 102(e) is legally deficient and should be withdrawn.

In addition, claim 1 recites “recommending at least one first financial account product to the applicant based on the received account preference information.” As explained, *Walters* does not disclose “receiving account preference information concerning various features of the financial product,” as recited in claim 1. Accordingly, *Walters* cannot, and does not, disclose “recommending at least one financial account product,” based on the account preference information. Instead, *Walters* determines financial products suitable for a client based on the client’s own personal, financial, and goal information. This is different from the “recommending” step, as recited in claim 1.

The Examiner further asserts *Walters* teaches the step of “providing to the applicant a plurality of selectable options for further defining predetermined features of the recommended financial account product,” as recited in claim 1 (Final Office action at p. 5). Applicants disagree for the following reasons. First, because *Walters* does not disclose “receiving account preference information from the applicant, the account preference information describing the applicant’s preferences concerning various features of the financial account product” (emphasis added), the reference cannot disclose “further defining predetermined features of the recommended financial account product.” Second, the cited portions (and any other portion) of *Walters* merely disclose report generating techniques and mechanisms for expected rates of return for a selected product (see e.g., *Walters* ¶¶ 0023-0025.) In particular, *Walters* discloses a set of rules which are applied to answers of sets of questions presented for determining whether any available financial products are appropriate for meeting a client’s financial situation and goals (see e.g., *Walters* ¶ 0014). However, implementing rules and questions does not teach or suggest providing an applicant with selectable options for further defining predetermined features of a recommended financial product, as recited in claim 1.

Moreover, the Examiner is incorrect in alleging *Walters* teaches “receiving the applicant’s selected options for the predetermined features of the recommended financial account product and customizing the recommended financial account product based on the applicant’s selected options.” For instance, in the previous Office Action, the Examiner relied on paragraphs 0005-0018 and 0023-0025 from *Walters* as evidence of the claimed features noted above (see Non-final Office action at p. 2). Applicants

disagree. *Walters* describes how a customer defines elements in a particular event, but does not disclose “customizing” a “recommended product.” And, because *Walters* does not disclose “receiving account preference information from the applicant,” as recited in claim 1, the reference falls short of disclosing “customizing the recommended financial account product based on the applicant’s selected options,” where the financial account product is recommended based on the “account preference information,” as recited in claim 1.

For these additional reasons, *Walters* does not anticipate the claimed invention. Thus, the rejection of claim 1 under 35 U.S.C. § 102(e) is legally deficient and should be withdrawn and the claim allowed.

Independent claims 6 and 11, although of different scope, recite features similar to those of claim 1. As explained, the cited art does not support the rejection of claim 1. Accordingly, the cited art does not support the rejection of claims 6 and 11 for at least the same reasons set forth above in connection with claim 1.

Claims 2-5, 7-10, 12-21 depend from independent claims 1, 6, and 11. As explained, the cited art fails to teach or suggest the recitations of claims 1, 6, and 11. As such, the cited art fails to support the rejection of claims 2-5, 7-10, and 12-21 for at least the same reasons set forth above for their respective independent claims. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by prior art. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-21 under 35 U.S.C. § 102(e) and allow the claims.

II. The rejection of claims 16-21 under 35 U.S.C. § 102(e)

The Examiner appears to reject claims 16-21 under 35 U.S.C. § 102(e).

However, in the body of the rejection, the Examiner does not address the recitations of these claims. This is improper under 37 C.F.R. § 1.104(c).

37 C.F.R. § 1.1104(c) requires the Examiner to provide more than merely stating a reference meets the limitations of a rejected claim. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 C.F.R. § 1.104(c)(2). In this case, not only is the reference asserted by the Examiner complex and describes many different embodiments, the Examiner improperly ignores recitations of claims 16-21. As such, the Examiner's rejection of each of these claims under 35 U.S.C. § 102(e) (or 35 U.S.C. § 103(a)) does not meet the requirements of 37 C.F.R. 1.104, and thus is improper. Further, to the extent the Examiner attempted to establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Examiner failed to show, *inter alia*, that the applied references, taken alone or in combination, teach or suggest each and every element recited in the claims. M.P.E.P. § 2143. Indeed, by ignoring the recitations of claims 16-21, the Examiner has failed to show how the cited art teach or suggest the recitations of these claims. As a result, the rejection of each of these claims does not meet the requirement of at least M.P.E.P. § 2143 and 35 U.S.C. § 103(a), and thus is improper.

Moreover, to the extent the Examiner has taken Official Notice that the recitations of claims 16-21 are well known, Applicants disagree and traverse the Examiner's position. An Official Notice rejection is improper unless the facts asserted are well-

known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. See M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicants submit that the recitations recited in claim 16-21 are not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. Accordingly, Applicants traverse the Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of these conclusions, or else withdraw the rejection.

Further, Applicants remind the Examiner of the following provision set forth in M.P.E.P. § 2144.03:

[w]hen a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

To the extent the Examiner is relying on personal knowledge in taking Official Notice that the features of claims 16-21 are well known, Applicants request that the Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner’s conclusions. For these additional reasons,

Applicants request that the rejection of claims 16-21, either under 35 U.S.C. § 103(a) or 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

III. Conclusion

Applicants respectfully request that the Examiner consider this response under 37 C.F.R. § 1.116. Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' claims. It is respectfully submitted that consideration of this paper would allow Applicants to reply to the final rejections and place the application in condition for allowance.



In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: February 20, 2007

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